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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re G-U Hardware, Inc.

Serial No. 76/051,359

James C. Wray, Esq. for applicant.

Sean W. Dwyer, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Cissel, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by G-U Hardware, Inc. to register the mark LIFT-SLIDE for "hardware for doors and windows, carriages, rollers, locking bolts, plugs, bottom guides, cover plates, bumpers, sealing pieces, handles, pulls, plates, stops, lift locking gear, locks, connecting bars, gaskets and end caps."¹

The Trademark Examining Attorney has refused

¹ Application Serial No. 76/051,359, filed June 18, 2000, alleging first use anywhere and first use in commerce in 1987.

registration on three bases: (i) that applicant failed to comply with a requirement to amend the identification of goods; (ii) that applicant's mark, when applied to applicant's goods, is merely descriptive thereof under Section 2(e)(1) of the Trademark Act; and (iii) that applicant's mark, when applied to applicant's goods, so resembles a previously registered mark as to be likely to cause confusion under Section 2(d) of the Act.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

Identification of Goods

The identification of goods, as noted above, reads "hardware for doors and windows, carriages, rollers, locking bolts, plugs, bottom guides, cover plates, bumpers, sealing pieces, handles, pulls, plates, stops, lift locking gear, locks, connecting bars, gaskets and end caps."

The Examining Attorney suggested an amended identification, but applicant declined to adopt it, maintaining that the identification is definite. The Examining Attorney asserts that the term "hardware" is indefinite, that the goods, as identified, can be classified in multiple classes, and that applicant must

clarify the identification by stating whether the "hardware" is "metal" or "nonmetal."

Applicant maintains that the identification of goods is definite as written, and that the Examining Attorney's suggestions are unnecessary.

Section 1402.03 of the Trademark Manual of Examining Procedure (TMEP) states that "[a] term that clearly includes particular items that are classified in more than one class is not acceptable." More specific to the current appeal is Section 1402.05(b) of the TMEP which provides that "[i]f an identification of goods is specific, but the goods could be classified in more than one class depending on the material composition, then the material composition must be indicated in the identification of goods." In the present case, applicant's hardware, if made of metal, is classified in International Class 6, whereas if the hardware were nonmetal, the goods would be classified in International Class 20.

The identification of goods is indefinite in the absence of an indication whether the "hardware" is "metal" or "nonmetal." Accordingly, the requirement for a more definite identification of goods is affirmed.

Mere Descriptiveness

The Examining Attorney maintains that the term LIFT-SLIDE is merely descriptive of a feature, function or purpose of the goods, namely that applicant's hardware is used to lift and slide doors and windows. In support of the refusal, the Examining Attorney submitted dictionary definitions of the words "lift" and "slide"; evidence obtained from various websites on the Internet; and excerpts retrieved from the NEXIS database.

Applicant contends that the term LIFT-SLIDE "is an unusual combination of words" and that the words "are verbs, not nouns or adjectives, which are commonly used as trademarks." (brief, p. 5) Applicant also argues that the Examining Attorney has improperly dissected the mark in considering mere descriptiveness and that, when properly considered as a whole, the mark is just suggestive. Applicant asserts that the record falls short of establishing mere descriptiveness, and that the record is devoid of any evidence showing that others in the field have used or would need to use the term LIFT-SLIDE to describe their similar goods.

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes

an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose, use or intended use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The term "lift" is defined as "to raise" and "slide" as "to glide; to move over a surface while maintaining smooth, continuous contact." The American Heritage Dictionary of the English Language (3rd ed. 1992).

A review of applicant's literature reveals the nature of applicant's hardware which is used in connection with "lift-sliding doors." According to the literature, the doors are "based on the effective and successful principle of lift, slide and lower." The literature goes on to state that the technology is "based on the successful lift-

sliding systems with lifting, tilting, sliding, lowering, sealing and locking functions."

Also of record are excerpts obtained from various websites on the Internet. The websites include references to "lift-slide doors" and "lift & slide door systems," also indicating that "[o]ne single operating handle activates a special hardware system that first 'lifts' the sliding door from a weather tight position[,] then 'slides' with ease on rollers and tracks at the head and sill." One excerpt states that the "hardware lifts the door panel off the weather stripping and allows it to roll freely." Another excerpt states that "[t]hese sliding doors also use the lift/slide operating system from Europe."

We find that, when used in connection with applicant's "hardware for doors and windows, carriages, rollers, locking bolts, plugs, bottom guides, cover plates, bumpers, sealing pieces, handles, pulls, plates, stops, lift locking gear, locks, connecting bars, gaskets and end caps," LIFT-SLIDE immediately describes, without conjecture or speculation, a significant characteristic or feature of the goods, namely, that they are used in connection with lift and slide door and window systems. As shown by applicant's literature, the goods enable a user to lift and slide large doors and windows easily. To purchasers of applicant's

goods, there is nothing in the term LIFT-SLIDE which, in the context of applicant's specific goods, would be ambiguous, incongruous or susceptible to any other plausible meaning.

In view of the above, the term LIFT-SLIDE, when applied to applicant's goods, is merely descriptive thereof under Section 2(e)(1) of the Act, so the refusal to register on this ground must be affirmed.

Likelihood of Confusion

Refusal under Section 2(d) of the Act was made on the basis of the previously registered mark TILT 'N SLIDE for "window assemblies, window sashes, window sash supporting hardware, namely, pivots, brackets, interconnecting members, carriers with or without rollers, handles, pivot shoes, sash retainers, sash clips, locks and latches, patio door assemblies, patio doors, patio door supporting hardware, namely, pivots, brackets, interconnecting members, carriers with or without rollers, handles, pivot shoes, sash retainers, sash clips, locks and latches."²

The Examining Attorney contends that the marks LIFT-SLIDE and TILT 'N SLIDE are similar in overall commercial impression, both marks' being formed by a descriptive word

² Registration No. 2,118,741, issued December 9, 1997 pursuant to the provisions of Section 2(f) of the Act.

followed by the same term "SLIDE." The Examining Attorney also points out that applicant's literature refers to "Lift-Tilt-Sliding Doors." Also weighing against registration, according to the Examining Attorney, is that the goods are related and that the goods are presumed to travel in similar channels of trade to similar classes of purchasers.

Applicant, in urging that the Section 2(d) refusal be reversed, argues that the marks are dissimilar in their entirety, that the goods are dissimilar and move in distinct trade channels, and that purchasers are careful and sophisticated. Applicant also points to the absence of any instances of actual confusion despite several years of contemporaneous use.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to compare the goods, we start with the premise that they need not be identical or even competitive to support a holding of likelihood of confusion. It is sufficient that the goods are related or that conditions surrounding their marketing are such that they are encountered by the same persons who, because of the relatedness of the goods and the similarities between the marks, would believe mistakenly that the goods originate from or are in some way associated with the same producer. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In this case, based on the identifications of goods in the cited registration and involved application, the goods are, at least in part, legally identical, or otherwise substantially similar. In the absence of any limitations in the identifications, it also is presumed that the goods move in the same channels of trade and are purchased by the same classes of purchasers. In re Elbaum, 211 USPQ 639 (TTAB 1981). Notwithstanding applicant's assertions on this point, the record is devoid of any evidence to suggest the contrary.

Accordingly, we turn to the question of whether the respective marks are sufficiently similar such that their

use in connection with the goods would be likely to cause confusion.

The marks must be considered in their entirety and, in this case, overall, the marks LIFT-SLIDE and TILT 'N SLIDE are not confusingly similar in sound, appearance and meaning. The only common element of the marks is the term "slide" which is merely descriptive when applied to the goods in the involved application and registration.³ Because marks must be considered in their entirety, the mere presence of a common descriptive or highly suggestive portion is usually insufficient to support a finding of likelihood of confusion. See: In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); and Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). We find that to be the case here, especially given that the other terms in the marks, namely, "lift" and "tilt," are different in sound and appearance, and the terms do not have the same meaning, either alone or in combination with the term "slide." See: General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992).

In view of the differences between the marks,

³ It is noted that the cited registration issued pursuant to Section 2(f) of the Act. See: In re Cabot Corp., 15 USPQ2d 1224 (TTAB 1990)[registration under Section 2(f) is tantamount to admission that the term lacks inherent distinctiveness].

purchasers in the marketplace are not likely to be confused, so the refusal to register under Section 2(d) must be reversed.

Decision

The refusal to register based on likelihood of confusion under Section 2(d) is reversed. The refusal to register because applicant failed to comply with the requirement for a more definite identification of goods is affirmed. The refusal to register based on mere descriptiveness under Section 2(e)(1) is affirmed.